

REMARKS

The application has been amended in manner believed to place it in condition for allowance at the time of the next Official action.

Claims 65-99 are new. Support for the new claims may be found generally throughout the specification, and particularly in the original claims. Claims 65-74 and 77-97 correspond to claims 33-42 and 44-64, respectively, discussed in the Official action. Claims 75 and 76 correspond to claim 43 discussed in the Official action. Claims 65-99 remain pending in this application. Claims 1-64 are canceled.

The Official Action objected to the language used in the abstract for allegedly using non-conventional terms (e.g. "functional") and the "use" of reagents without providing any examples. Applicants respectfully disagree.

According to 37 CFR 1.72, "[t]he purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure."

The present abstract states "an ionic liquid is used as liquid matrix for organic synthesis in homogeneous phase on soluble support". The abstract further describes the functional characteristics and general formula of the ionic liquid. Organic

synthesis is conventionally completed on a solid support. The terms are defined in the specification (e.g. at page 3).

Accordingly, it is respectfully submitted that the present abstract meets the requirements of 37 CFR 1.72. The abstract describes the nature and gist of the present application is organic synthesis in a homogeneous phase on a soluble support (i.e. as opposed to solid support) where the liquid matrix for organic synthesis is an ionic liquid of the described formula.

As to replacing some of the alleged non-conventional terms in the abstract, the terms are already defined in the specification. Including terms in the abstract not described in specification may introduce new matter to the disclosure.

As to providing examples in the abstract, 37 CFR 1.72 does not require examples.

In view of the above, applicants respectfully request that the objection to the abstract be withdrawn.

The drawings were objected to because the figures have machine marks and/or black dots covering the page. Applicants respectfully submit that the present drawings comply with 37 CFR 1.84, and it is unclear to the applicants whether the machine marks and black dots actually prevented examination. Nevertheless, "cleaner" drawings are included with this amendment, and applicants respectfully request that the objection to the drawings be withdrawn.

The Official Action stated in paragraph 3 that the "instance" [sic] application is allegedly indefinite, confusing, and written in improper English such that it is not clear what is being claimed. The Official Action further required a substitute specification because the specification is allegedly riddled with non-standard terminology and confusing, prolix phrases. Applicants respectfully disagree.

Applicants believe that the present specification complies with 37 CFR 1.71 and 37 CFR 1.52.

The present application is a National stage application of International Application PCT/FR2003/002795, and the translation is a verified English translation.

As to the alleged non-standard terminology, the Examiner's attention is respectfully directed to MPEP 2111.01. The instant specification does define terms that may not be considered standard terminology. For example, "function", "functional" and "functionalized" are all discussed at pages 3-6 of the specification (particularly page 3, lines 15-23, page 5, lines 6-13, and page 6, lines 15-26). Applicants believe that one of ordinary skill in the art would understand the recited terms in light of the specification.

Indeed, the clarity of the specification is made evident by the fact that the Official action proposes synonymous terms in place of the alleged non-standard terms. In doing so, it appears that the Official Action required a substitute

specification in order that applicants comply with a personal preference in writing style, not with United States patent practice. Therefore, applicants respectfully request that the objection to the specification be withdrawn.

The Official Action concludes in paragraph 7 by stating "[d]ue to the extensive nature of errors in the present claims and their indefinite nature, no meaningful search was possible." Applicants believe that the present application was searchable, not only for the reasons discussed above, but also in view of the fact that the International Searching Authority was able to search and examine similar claims in the international application. Thus, the Patent Office even had the benefit of the International Search Report, but did not explain why no meaningful search was possible for claims similar to those searched and examined by the International Searching Authority.

Applicants are deeply troubled by the last sentence of paragraph 7 of the Official Action. The Official Action stated that "it is anticipated that the next Office action will be final" without applicants ever receiving an Official action on the merits or even a review of relevant art. This is clearly improper according to MPEP 706.07:

"Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the

applicant should amend with a view to avoiding all the grounds of rejection and objection."

"The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits."

As to the rejection of the claims, applicants amended the claims for clarification purposes in a manner believed to be consistent with U.S. patent practice.

The Official action rejected claims 33-64 under 35 U.S.C. 112, second paragraph, as being indefinite.

Claims 33-64 were rejected, in general, as prolix and not being consistent with U.S. patent practice. The Official Action specifically rejected the claims because of narrow and broad limitations in the same claim, Markush terminology, and reciting the names of inventors referring to a reaction, which would be analogous to reciting a trademark. Claim 33 was also rejected for reciting a method without any steps.

Claims 33-64 are cancelled. New claims 65-99 are directed to subject matter similar to claims 33-64. Claims 65-99 do not recite a narrow limitation within a broad limitation or improper Markush groups, but the claims do recite method steps in the method claims.

As to the general form of the claims, applicants believe the claims are consistent with U.S. patent practice, such as reciting "wherein" instead of "characterized in that" and presenting a generic formula before identifying the variables. Terminology that is readily apparent in light of the specification, such as "functional", remains in the claims.

With respect to the recitation of names of inventors referring to a reaction being analogous to a trademark, applicants respectfully disagree. Instead, reaction names would be considered names used in trade, not trademarks, which according to MPEP 608.01 (v), are permissible if their meanings are well known in this country and satisfactorily defined in literature. This is further supported by the fact that issued patents do recite reactions by inventor name in their claims.

Therefore, applicants respectfully submit that new claims 65-99 are definite, and respectfully request that the rejection be withdrawn.

Claims 33-45, 63 and 64 were rejected under 35 U.S.C. 101 as failing to meet the utility requirement for reciting a "use" without reciting particular method steps.

Claims 33-45, 63 and 64 are cancelled. New claims 65-78, 96 and 97 correspond to claims 33-45, 63 and 64, respectively, and recite specific method steps.

Therefore, applicants respectfully submit that new claims 65-78, 96 and 97 meet the utility requirement.

Claims 58-62 were rejected under 35 U.S.C. 101 as failing to meet the utility requirement for reciting a "use" without reciting particular method steps.

Claims 58-62 are cancelled. New claims 91-95 and 99 are directed to subject matter similar to claims 58-62, and claims 91-95 correspond to claims 58-62, respectively. Claims 91 and 99 recite specific method steps, and claims 92-95 further describe the steps recited in claim 91.

Therefore, applicants respectfully submit that new claims 91-95 and 99 meet the utility requirement.

Claims 33-64 were also rejected under 35 U.S.C. 112, first paragraph, as failing to meet the enablement requirement. Specifically, the claims were rejected for reciting reactions more broadly than exemplified.

Claims 33-64 are cancelled. New claims 65-99 are directed to subject matter similar to claims 33-64. The present specification discloses methods, reactions and compositions in a manner similar to claims 65-99. Thus, new claims 65-99 do meet the enablement requirement.

Please charge the fee of \$200 for one extra independent claim and \$150 for three claims of any type added herewith to Deposit Account No. 25-0120.

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Claims 58-62 were rejected under 35 U.S.C. 101 as failing to meet the utility requirement for reciting a "use" without reciting particular method steps.

Claims 58-62 are cancelled. New claims 91-95 and 99 are directed to subject matter similar to claims 58-62, and claims 91-95 correspond to claims 58-62, respectively. Claims 91 and 99 recite specific method steps, and claims 92-95 further describe the steps recited in claim 91.

Therefore, applicants respectfully submit that new claims 91-95 and 99 meet the utility requirement.

Claims 33-64 were also rejected under 35 U.S.C. 112, first paragraph, as failing to meet the enablement requirement. Specifically, the claims were rejected for reciting reactions more broadly than exemplified.

Claims 33-64 are cancelled. New claims 65-99 are directed to subject matter similar to claims 33-64. The present specification discloses methods, reactions and compositions in a manner similar to claims 65-99. Thus, new claims 65-99 do meet the enablement requirement.


Please charge the fee of \$200 for one extra independent claim and \$150 for three claims of any type added herewith to Deposit Account No. 25-0120.



The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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Appendix:

The Appendix includes the following items:

- cleaner copies of the figures